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To: **Mail Stop Appeal Brief- Patents**
Examiner David A. Rogers, Group Art Unit: 2856
Fax No.: (571) 273-8300
From: George M. Macdonald
Date: September 25, 2006
Subject: Serial No.: 10/065,286
Pages: 23 (including this cover)

Re: U.S. Patent Application Serial No.: 10/065,286
Confirmation No.: 5702
Our Docket # F-380

Enclosed please find Appellant's Amended Brief on Appeal in furtherance of the June 1, 2006 Notice of Appeal and in response to the August 24 Notice of Non-Compliant Appeal Brief.


CERTIFICATION OF FACSIMILE TRANSMISSION

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1. Appellant's Amended Brief on Appeal (22 pages).

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Serial No.: 10/065,286
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:) Attorney Docket No.: F-380
Christian A. Beck) Customer No.: 00919
Serial No.: 10/065,286)
Filed: September 30, 2002) Examiner: Rogers, David A.
Confirmation # 5702) Group Art Unit: 2856
Date: September 25, 2006

Title: HAZARDOUS MATERIAL DETECTOR FOR DETECTING
HAZARDOUS MATERIAL IN A MAILSTREAM

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450


APPELLANT'S AMENDED BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-16 of the above-identified application mailed March 1, 2006. This Amended Brief is in response to the August 24, 2006 Notice of Non-Compliant Appeal Brief regarding the August 1, 2006 Appeal Brief. The third Notice of Appeal was filed in this case on June 1, 2006 and this is the associated third brief after the first final rejection approximately 32 months earlier. Accordingly, this brief is timely filed. **No fee is believed due.** The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on September 25, 2006 (Date of Transmission).
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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-16 are in the case and under final rejection of the Examiner.

Claims 1, 2, 6-10 and 16 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846") in view of United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009"), "Guardian Reader System Frequently Asked Questions" by Alexeter Technologies, LLC and in further view of United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281").

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009") in view of in further view of United States Patent No. 4,840,919 to Attar ("Attar '919"), United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846"), "Guardian Reader System Frequently Asked Questions" by Alexeter Technologies, LLC and United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281").

Claims 11-15 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846") in view of United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009"), United States Patent No. 4,840,919 to Attar ("Attar '919"),

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and United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281") and in further view of the legal precedent *In re Ngai*, 70 USPQ 2d 1862 ("Ngai").

Appellant hereby appeals the rejection of claims 1-16.

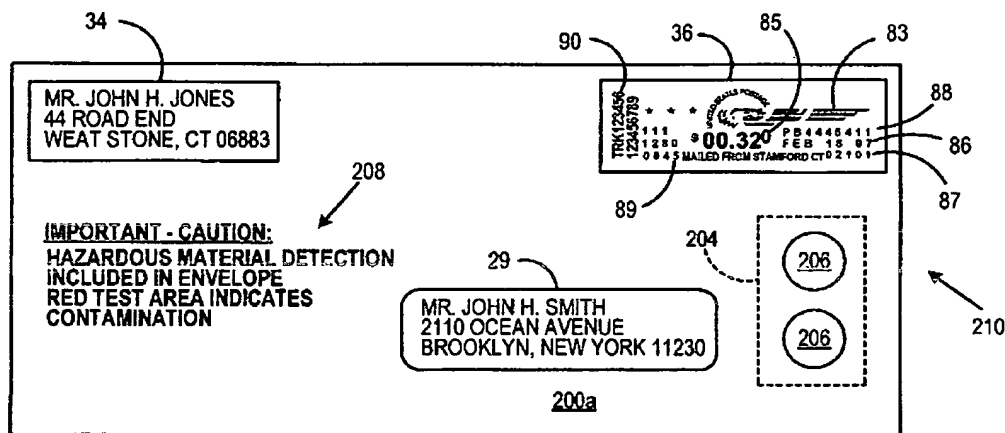
IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of March 1, 2006. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection. Appellant disagrees that the March 1, 2006 Office Action was properly made final.

V. Summary of Claimed Subject Matter

Appellants' invention relates to hazardous material detectors for detecting hazards in a mail stream. Figure 6 is reproduced below for use in a summary discussion of an illustrative embodiment. As can be appreciated from Figure 6 and the associated description at paragraphs 47-49 of the specification, a hazardous material

FIG. 6



detection mailpiece 210 has a recipient address field 29 printed on the envelope front side 200a and a sender address field 8. A postal indicia 36 is affixed to mailpiece 30. Indicia 36 contains a dollar amount 85; the date 86 that postal indicia 36 was affixed to mailpiece 30; the place 87 that mailpiece 30 was mailed; the postal meter serial number

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88; an eagle 83; a security code 89; and, a tracking number 7. Security code 89 and tracking number 90 are unique numbers that are derived from address field 29 and information contained in the postage meter that affixed indicia 36. The hazardous material detection mailpiece 210 includes a hazardous material test strip 204 which can be viewed through one or more holes 206 in the mailpiece. The holes 206 can be positioned adjacent to indicia 36 or any other suitable position including the back side of the mailpiece. The number of holes can be determined by one of ordinary skill in the art considering factors including the size of the test strip 204.

In an embodiment having a test strip insert, a printer is positioned to print on the insert, and in this example, to print a barcode or Identification (ID) number on the insert. The ID number would serve to preserve a record the time, date or other information pertaining to the insert so that the identification information could later be used in processing. For example, if the envelope 200 containing the insert 204 was destroyed, the ID number could be used to determine when the insert was prepared etc.

As described in the background, there was a need for a reliable way to quickly and cost effectively sample and/or detect small amounts of loose and possibly dangerous particulate matter in the mail processing equipment.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to be Reviewed on Appeal

Whether Claims 1, 2, 6-10 and 16 are patentable under 35 U.S.C. 103(a) over United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846") in view of United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009"), "Guardian Reader System Frequently Asked Questions" by Alexeter Technologies, LLC and in further view of United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281").

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Whether Claims 1-5 are patentable under 35 U.S.C. 103(a) over United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009") in view of in further view of United States Patent No. 4,840,919 to Attar ("Attar '919"), United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846"), "Guardian Reader System Frequently Asked Questions" by Alexeter Technologies, LLC and United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281").

Whether Claims 11-15 are patentable under 35 U.S.C. 103(a) over United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846") in view of United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009"), United States Patent No. 4,840,919 to Attar ("Attar '919"), and United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281") and in further view of the legal precedent *In re Ngai*, 70 USPQ 2d 1862 ("Ngai").

VII. Argument

As Appellant discusses in detail below, the final rejection of claims 1-16 does not support the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The Weisenberg '009 and Tawil '281 References are Not Properly Combined Under 35 U.S.C. Section 103(a) with Robinson '846

As described more fully below, the three groups of obviousness rejections put forth by the Examiner in the Final Rejection rely on the combination of at least four (4) references and as many as five (5) references. Furthermore, the Examiner additionally relies upon legal precedent in an attempt to cure the deficiencies of the prior art in one rejection below. The Weisenberg '009 and Tawil '281 references are cited in each of the three rejections and Appellant addresses the improper combination here for

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purposes of clarity and brevity and the arguments of this section are incorporated into the sections below.

Appellant argues that there is no motivation to combine the Weisenberg '009 and Tawil '281 references with the Robinson '846 reference. For the rejection to stand, there must be some teaching, suggestion or motivation to combine the references found in the references themselves or the general knowledge of one of skill in the art. *Citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the Examiner used the invention itself as the roadmap to justify combining non-analogous references that teach away from the combination by stating that

Robinson, Jr. does not expressly teach the use of an envelope with a plurality of holes as seen on line 3 of the applicant's claim 1. It is, however, known in envelope manufacturing to provide the envelopes with a plurality of holes. One can see exemplary examples of these types of envelopes in Weisenberg et al. (see figures 5a-10). Furthermore, the Government, among others, has employed reusable inter-office/inter-facility envelopes for decades. These envelopes also comprise a plurality of holes located on the front side and back side. (March 1, 2006 Final Office Action, p. 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Robinson, Jr., with the teachings of Weisenberg et al., Alexeter, and Tawil et al. to provide a hazardous material test strip with an envelope having a plurality of holes wherein a machine-readable tag is included with the test strip and is associated with time data.

The plurality of holes, as taught by Weisenberg et al., would allow one to easily determine if there are any remaining contents, e.g. letters, papers, coins, small items, that must be removed prior to disposal or reuse of the envelope. (March 1, 2006 Final Office Action, p. 5).

Appellant respectfully submits that there is no motivation to combine the cited references as suggested by the Examiner.

With regard to the Weisenberg '009 reference, there is no suggestion of testing for anthrax or other hazardous material, because the reference specifically teaches that the holes are placed in the envelope so that anthrax would not stay in the envelope. See Weisenberg '009 at paragraph 38. According to the express teachings of

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Weisenberg '009, the contaminants do not remain in the envelope. Therefore, there would be no motivation to combine a reference that would test for them.

Furthermore, the Examiner states above "Robinson, Jr. does not expressly teach the use of an envelope with a plurality of holes." In fact, Robinson '846 explicitly teaches that the envelope must be sealed and thus could not possibly have holes. In Robinson '846, "[t]he indicator compound must be in communication with the interior of the package or container but must be read from the outside without opening the package or container which must further provide an effective seal against leakage of any bacteria therein." See Robinson '846 at Col. 2, lines 40-45 (emphasis added). Therefore, there is a specific teach away of the combination suggested by the Examiner.

Accordingly, it is clear that the Examiner has employed improper hindsight using the present invention as a roadmap to combine references having no other motivation to be combined other than the teachings of the instant application. The distinction is made even clearer by reference to the illustrative embodiments of the present application in which the claimed envelope with holes and enclosed test strip are used as a probe to be fed through mail sorting equipment so that cross contamination in the machine will enter the envelope and be detected. The combination suggested by the Examiner is clearly improper and the rejections should be reversed.

With regard to the Tawil '281 reference, the Examiner states:

Associating the electronic tag of Robinson, Jr. with time data would allow one to know the time elapsed since the test strip was manufactured in order to know if the test strip has exceeded its shelf life, i.e., is no longer safe to use as a hazardous material detector. Likewise, associating the test strip with time data would allow one to know how long the test strip was opened so that it can be used in a timely manner. (March 1, 2006 Final Office Action, p. 5).

The Tawil '281 reference does not appreciate the problem of providing a test strip that changes color and is visible through a hole. In Tawil '281, the test strip is inserted in a remote reader to determine radiation dosage levels and is in no way related to the art of test strips providing a visible indication. As the Federal Circuit has held, "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to

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piece together the teachings of the prior art ..." See *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1998).

Additionally, the Tawil '281 reference describes devices, systems and methods for measuring radiation dosage received by a user wearing the device. Clearly, Tawil '281 is not even remotely related to envelope test strip devices and is not at all pertinent to the claimed invention. One of skill in the art would not look to Tawil '281 to modify Robinson '846. Accordingly, the references are not properly combined. See *Wang Lab., Inc. v. Toshiba Corp.*, 993 F. 2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Accordingly, the references are not properly combined and each of the rejections discussed below should be reversed.

B. Claims 1, 2, 6-10 and 16 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1, 2, 6-10 and 16 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846") in view of United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009"), "Guardian Reader System Frequently Asked Questions" by Alexeter Technologies, LLC and in further view of United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281").

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success

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must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

As described above in subsection A, the cited references are not properly combined and thus the Examiner has failed to establish a prima facie rejection and the rejection should be reversed.

Claim 1 is directed to a hazardous material detector including a test strip and is shown below:

1. A hazardous material detector comprising:
 - an envelope comprising a front side and a back side;
 - holes formed in at least one of the front side or the back side of the envelope;
 - a hazardous material test strip for detecting the presence of hazardous material in contact with the test strip;
 - wherein the test strip includes an identifier associated with time data; and
 - whereby when hazardous materials are detected by the hazardous material test strip a physical change occurs to the hazardous material test strip and the physical change can be viewed through at least one hole formed in the at least one of the front side or the back side of the envelope. (emphasis added).

In the March 1, 2006 Final Office Action, the Examiner rejected claims 1, 2, 6-10 and 16 under 35 U.S.C. section 103(a). Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

As described above, Tawil '281 is not properly combined. In the earlier February 16, 2005 Final Office Action, the Examiner admits that Tawil '281 operates in a different manner and is directed to radiation exposure measurement and not contaminant detection. See February 16, 2005 Final Office Action, pages 2, 8. Appellant additionally respectfully submits that Tawil '281 is in non-analogous art. The other cited references do not appreciate the need to associate time with a test strip. There is no motivation to add such a limitation without impermissible hindsight and using the present claim as a roadmap. One of skill in the art would not look to a radiation detector

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to modify the contaminant detectors of the other cited references – nor would they need to. The other cited references appreciate only the problem of detecting contaminants such as Anthrax and describe such detectors. Such persons of skill in the art would not need to search for other detectors and would have no reason to search radiation detector art.

Even if properly combined, the cited references do not render the claim as a whole obvious. There is nothing in the cited art to suggest a device that can test for contaminants outside as the recited holes allow and certainly nothing to suggest viewing the internal test strip through a hole.

Robinson '846 does not in any way teach or suggest a test strip that includes an identifier associated with time data and the Tawil '281 reference does not have any suggestion of shelf life or monitoring shelf life. See Final Office Action, page 5.

Appellant respectfully submits that Tawil '281 does not teach a test strip and certainly not one in which a physical change can be monitored thorough a hole. Accordingly, even if the references were to be found to be properly combined, the references do not teach or fairly suggest the invention as presently claimed and in particular do not teach or suggest a test strip for detecting the presence of hazardous material in contact with the test strip, a test strip having an identifier associated with time data where a physical change can be viewed through at least one hole.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection. Dependent claims 2, 6-10 and 16 are patentable over the cited references for at least the same reasons.

Furthermore, regarding claim 16, the Examiner has not shown any teaching or suggestion of a device having a "holder [that] substantially fits the envelope and wherein the holder does not move substantially while positioned inside the envelope."

For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 1, 2, 6-10 and 16 is in error and should be reversed.

C. Claims 1-5 are Not Unpatentable Under 35 U.S.C. Section 103(a)

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Claims 1-5 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009") in view of in further view of United States Patent No. 4,840,919 to Attar ("Attar '919"), United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846"), "Guardian Reader System Frequently Asked Questions" by Alexeter Technologies, LLC and United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281"). Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

As described above in subsection A, the cited references are not properly combined and thus the Examiner has failed to establish a prima facie rejection and the rejection should be reversed.

Claim 1 is directed to a hazardous material detector including a test strip and is shown below:

1. A hazardous material detector comprising:
 - an envelope comprising a front side and a back side;
 - holes formed in at least one of the front side or the back side of the envelope;
 - a hazardous material test strip for detecting the presence of hazardous material in contact with the test strip;
 - wherein the test strip includes an identifier associated with time data; and
 - whereby when hazardous materials are detected by the hazardous material test strip a physical change occurs to the hazardous material test strip and the physical change can be viewed through at least one hole formed in the at least one of the front side or the back side of the envelope. (emphasis added).

Even if properly combined, the cited references do not render the claim as a whole obvious. There is nothing in the cited art to suggest a device that can test for contaminants outside as the recited holes allow and certainly nothing to suggest viewing the internal test strip through a hole.

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Robinson '846 does not in any way teach or suggest a test strip that includes an identifier associated with time data and the Tawil '281 reference does not have any suggestion of shelf life or monitoring shelf life. See Final Office Action, page 7.

Appellant respectfully submits that Tawil '281 does not teach a test strip and certainly not one in which a physical change can be monitored through a hole. Accordingly, even if the references were to be found to be properly combined, the references do not teach or fairly suggest the invention as presently claimed and in particular do not teach or suggest a test strip for detecting the presence of hazardous material in contact with the test strip, a test strip having an identifier associated with time data where a physical change can be viewed through at least one hole.

With regard to Claim 3, Claim 3 depends indirectly from claim 1 and is patentable for at least the reasons as described above with reference to claim 1. Additionally, they are patentable over the cited reference for the following reasons. Claim 3 recites:

3. The hazardous material detector as claimed in claim 2 wherein the holder and hazardous material test strip mounted thereon are smaller than the envelope and whereby the holder move while positioned inside the envelope. (emphasis added).

The Examiner cites to Attar '919, but does not show a holder in a carrier in which the test strip may move. Furthermore, Attar '919 does not appreciate the problem of placement of a holder in relation to an envelope and holes as claimed. In direct contradiction to the rejection provided, the holder as claimed allows the test strip to be reused, while the device of Robinson, Jr. '846 is embedded. Therefore, the Examiner has impermissibly used the invention as presently claimed and improper hindsight in formulating the rejection. The cited references do not appreciate the problem of reusing the test strip and placing it in a holder to enable viewing it through the hole.

In a very clear application of impermissible hindsight using the present application as a roadmap, the Examiner states:

The detector of Attar, when placed in any envelope including those from Weisenberg et al., will help ensure that any residual hazardous materials will be detected, or if the material spills onto other envelopes,

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the indicator can detect when cross-contamination occurs. (March 1, 2006 Final Office Action, p. 5).

There is absolutely no suggestion or teaching of the problem of detecting cross-contamination in mail processing machines. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection. For at least these reasons, Appellant respectfully submits that the final rejection as to claim 3 is in error and should be reversed.

Claims 4-5 that depend directly or indirectly from claim 1 and 3 are patentable over the cited references for at least the same reasons. For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 1-5 is in error and should be reversed.

D. Claims 11-15 are Not Unpatentable Under 35 U.S.C. Section 103(a)

Claims 11-15 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 6,542,842 B1 to Robinson, Jr., ("Robinson '846") in view of United States Patent Application Publication 2004/0046009 A1 by Weisenberg, et al. ("Weisenberg '009"), United States Patent No. 4,840,919 to Attar ("Attar '919"), and United States Patent No. 5,179,281 to Tawil, et al. ("Tawil '281") and in further view of the legal precedent *In re Ngai*, 70 USPQ 2d 1862 ("Ngai"). Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

As described above in subsection A, the cited references are not properly combined and thus the Examiner has failed to establish a prima facie rejection and the rejection should be reversed.

Claim 11 depends directly from claim 1 and is patentable for at least the reasons as described above with reference to claim 1. Additionally, they are patentable over the cited reference for the following reasons. Claim 11 recites:

11. The hazardous material detector as claimed in claim 1 further comprising:
a warning message on the envelope. (emphasis added).

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Furthermore, the Applicant respectfully submits that the Examiner has misconstrued the holding of the Ngai decision. The Federal Circuit did not state that all instructions would not add patentable weight to an underlying object. In fact, if the instructions are interrelated so as to produce a new product, the Federal Circuit stated that the new product might indeed be patentable. See In re Ngai, 367 F.3d 1336, 1338, 70 USPQ 2d 1862 (Fed. Cir. 2004).

Here, the invention as claimed in claim 11 recites a warning message on the envelope that is clearly interrelated with the underlying object.

Appellant respectfully submits that the Examiner has improperly applied the holding of Ngai by stating that the warning message serves only to instruct. Such instructions could be provided to the postal operator of the effected mail processing equipment in a manual. Here, however, the "instructions" are interrelated by being placed on the envelope – not in a "placard in a mail processing facility" as suggested by the Examiner at page 11 of the final rejection. Accordingly, the Examiner has admitted that there are non-interrelated ways of presenting such instructions and thus it logically flows that the recitation in claim 11 limited to the "instructions" placed on the envelope is interrelated and thus should be afforded patentable weight.

Ngai distinguished *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983) ("Gulack") by generally stating that separate instructions teaching a new way of using a known device if instructions are known in the art do not add patentable weight. However, if the instructions are interrelated so as to produce a new product, the Federal Circuit stated that the new product might indeed be patentable. Here the instructions are attached to the device and part of the device and therefore must be afforded patentable weight. Not only does the "printed matter" depend on the "kit", it is embodied in a physical form that is attached to the "kit."

As clearly recited in Gulack,

The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384 (emphasis added), cited by *In re Lowry*, 32 F.3d 1579, 1582; 32 U.S.P.Q.2D 1031 (CAFC 1994).

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Furthermore, the Court stated in *Gulack*:

A "printed matter rejection" under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. A printed matter rejection is based on case law antedating the 1952 patent act, employing a point of novelty approach. In *re Sterling*, 21 C.C.P.A. 1134, 70 F.2d 910, 21 U.S.P.Q. (BNA) 519 (1934). The 1952 act legislatively revised that approach through its requirement that the claim be viewed as a whole in determining obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. (BNA) 459, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966). The CCPA has considered all of the limitations of the claims, including the printed matter limitations, in determining whether the invention would have been obvious. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. (BNA) 580 (CCPA 1974); *In re Cavrich*, 59 C.C.P.A. 883, 451 F.2d 1091, 172 U.S.P.Q. (BNA) 121 (1971). In *Royka*, 490 F.2d at 985, 180 U.S.P.Q. (BNA) at 583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated. *Gulack*, 703 F.2d at 1385 n.8 (emphasis added), *cited by In re Lowry*, 32 F.3d 1579, 1583; 32 U.S.P.Q.2D 1031 (CAFC 1994).

The court in *Lowry* went on to state:

In *Gulack*, this court concluded that "the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386 (footnote omitted), *cited by In re Lowry*, 32 F.3d 1579, 1583; 32 U.S.P.Q.2D 1031 (CAFC 1994).

Here, the claimed element recites a warning attached to the substrate – clearly a functional relationship that none of the cited references teach or suggest.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection. For at least these reasons, Appellant respectfully submits that the final rejection as to claim 11 is in error and should be reversed.

Claims 12-15 that depend directly or indirectly from claim 1 and 11 are patentable over the cited references for at least the same reasons.

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Furthermore, regarding claim 13, the invention as claimed recites a physical label adhered to the envelope that is clearly interrelated with the envelope and not an instruction to use an envelope without the label.

13. The hazardous material detector as claimed in claim 12 wherein:
the warning message comprises a label affixed to the envelope.

Furthermore, regarding claim 15, the invention as claimed recites a physical label adhered to the envelope that is clearly interrelated with the envelope that is placed adjacent to at least one hole and is clearly not an instruction to use an envelope without the label.

15. The hazardous material detector as claimed in claim 11 wherein:
the warning message is placed adjacent to the at least one hole.

For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 11-15 is in error and should be reversed.

IX. Conclusion

In Conclusion, Appellant respectfully submits that the final rejection of claims 1-16 is in error for at least the reasons given above and therefore, should be reversed.

Respectfully submitted,


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APPENDIX A

1. A hazardous material detector comprising:
an envelope comprising a front side and a back side;
holes formed in at least one of the front side or the back side of the envelope;
a hazardous material test strip for detecting the presence of hazardous material in contact with the test strip;
wherein the test strip includes an identifier associated with time data; and
whereby when hazardous materials are detected by the hazardous material test strip a physical change occurs to the hazardous material test strip and the physical change can be viewed through at least one hole formed in the at least one of the front side or the back side of the envelope.
2. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is mounted on a holder.
3. The hazardous material detector as claimed in claim 2 wherein the holder and hazardous material test strip mounted thereon are smaller than the envelope and whereby the holder move while positioned inside the envelope.
4. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is mounted on a holder and contained in a carrier.
5. The hazardous material detector as claimed in claim 4 wherein holes are formed in the carrier.
6. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is positioned adjacent to the front side of the envelope.
7. The hazardous material detector as claimed in claim 1 wherein the hazardous material test strip is positioned adjacent to the back side of the envelope.

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8. The hazardous material detector as claimed in claim 1 further comprising:
a window on the front side of the envelope.
9. The hazardous material detector as claimed in claim 1 wherein:
the physical change comprises a change in color.
10. The hazardous material detector as claimed in claim 9 wherein:
the change in color is to red.
11. The hazardous material detector as claimed in claim 1 further comprising:
a warning message on the envelope.
12. The hazardous material detector as claimed in claim 11 wherein:
the warning message identifies the physical change associated with the
presence of a harmful material.
13. The hazardous material detector as claimed in claim 12 wherein:
the warning message comprises a label affixed to the envelope.
14. The hazardous material detector as claimed in claim 12 wherein:
the warning message comprises a message printed on the envelope using ink.
15. The hazardous material detector as claimed in claim 11 wherein:
the warning message is placed adjacent to the at least one hole.
16. The hazardous material detector as claimed in claim 2 wherein:
the holder substantially fits the envelope and wherein the holder does not move
substantially while positioned inside the envelope.

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Appendix IX – Evidence Appendix

None

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Appendix X – Related Proceedings Appendix

None

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